

### **REMARKS/ARGUMENTS**

This Amendment is in response to the Office Action dated December 14, 2004. This Amendment is being submitted within the three month period for response extending to March 14, 2005. The current status of the claims is summarized below.

5           Claims 1-20 are currently amended.

          Claims 1-20 are pending in the application after entry of the present Amendment.

#### **Drawings**

          Please note that the paragraph beginning at page 24, line 3, has been amended to  
10   include reference to items 606 and 610 in Figure 6. Therefore, the Applicants request the  
Office to withdraw the objections to the drawings.

          Additionally, please note that the Abstract has been amended to remove the phrase  
"An invention is disclosed." Therefore, the Applicants request the Office to withdraw the  
objections to the Abstract.

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#### **Claim Objections**

          Please note that claim 7 has been amended to depend from claim 5, rather than  
claim 9.

#### **Rejections under 35 U.S.C. § 112**

20           Claims 4-7 were rejected under 35 U.S.C. §112, second paragraph, as being  
indefinite for failing to particularly point out and distinctly claim the subject matter which  
applicant regards as the invention. These rejections are traversed.

          With respect to claim 4, the Office has indicated that "assertion result set" lacks  
25   proper antecedent basis. However, the Applicants respectfully point out that the phrase

"assertion result set" is preceded by "an." Thus, the phrase "an assertion result set" as recited in claim 4 does have sufficient antecedent basis. Therefore, the Office is requested to withdraw the rejections of claims 4-7 under 35 U.S.C. §112, second paragraph.

5    **Rejections under 35 U.S.C. § 101**

Claims 1-20 were rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. These rejections are traversed.

10    The Office has asserted that the method of claim 1 consists solely of manipulation of an abstract idea without any limitation to a practical application. Claim 1 has been amended to recite "using the sentences marked as testable to determine whether a test suite for testing the computer program is adequate." Therefore, the method of claim 1, as amended, recites a practical application.

15    In view of the foregoing, the Office is requested to withdraw the rejection of claim 1 under 35 U.S.C. §101. Additionally, because each of claims 2-7 ultimately depends from claim 1, each of claims 2-7 is patentable for the same reasons as claim 1. Therefore, the Office is requested to withdraw the rejections of claims 2-7 under 35 U.S.C. §101.

20    The Office has rejected claims 8-20 as being directed to a computer program. Claims 8-20 have been amended to recite a computer readable media including program instructions. Thus, the Office is requested to withdraw the rejections of claims 8-20 under 35 U.S.C. §101.

**Rejections under 35 U.S.C. § 102**

Claims 1-20 were rejected under 35 U.S.C. §102(e) as being anticipated by Pavela (U.S. Patent No. 6,332,211). These rejections are respectfully traversed.

Pavela discloses a method for generating test cases using a test object library, wherein the test cases are used for testing software. Pavela teaches definition of a source file that includes a number of tags. Each tag is associated with a particular executable code object that defines a set of instructions for performing a particular test procedure on a particular software program. The source file is used to generate a test plan in a conversational language. The source file is also used to generate an automated test code for testing the particular software program. More specifically, the automated test code is generated using a technique in which commands to system elements are issued and messages responsive to the commands are intercepted and used to provide test results.

It should be appreciated that Pavela is not concerned with and does not teach automated acquisition of assertions in a specification of a computer program, as claimed by the present invention. Rather Pavela is concerned with teaching a method for testing computer software by providing a tool that can be used to develop test cases for the particular computer software to be tested. Nevertheless, in the interest of furthering prosecution of the present invention, claims 1-20 have been amended to be further distinguished from the teachings of Pavela. The present invention is distinguished from the teachings of Pavela for at least the reasons discussed below.

With respect to claims 1, 8, and 14, Pavela does not teach receiving a specification of a computer program as an input. The Office has asserted that the source file of Pavela teaches the specification of a computer program, as required by the present invention. However, the source file of Pavela is created by a user to generate a test plan for software testing and to generate an automated test code. Thus, the source file of Pavela is not equivalent to a specification of a computer program. Furthermore, the source file of Pavela is not described as including a plurality of sentences describing the computer program. It should be further noted that a tag or test code object identifier as

disclosed by Pavela is simply not equivalent to a sentence or a context, as required by the present invention.

Further with respect to claims 1, 8, and 14, Pavela does not teach determining whether a sentence obtained from the specification of the computer program is a testable  
5 assertion, wherein the testable assertion describes behavior of an application programming interface that can be tested. The Office has asserted that the tag as disclosed by Pavela is equivalent to a testable assertion. However, the tag of Pavela is described as an entity used to identify and delineate information entered in the source file. The tag of Pavela does not describe behavior of a testable application programming interface, as  
10 required by the testable assertion of the present invention.

Further with respect to claim 8, Pavela does not teach identification of a context within the specification of the computer program. Additionally, Pavela does not disclose parsing the context within the specification of the computer program to obtain sentences.

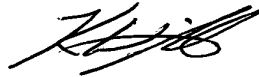
A claim is anticipated only if each and every element of the claim is found, either  
15 expressly or inherently described, in a single prior art reference. Since Pavela does not disclose each and every feature of claims 1, 8, and 14, as discussed above, Pavela does not anticipate claims 1, 8, and 14. Therefore, the Applicants respectfully request the Office to withdraw the rejections of claims 1, 8, and 14.

Additionally, since each of claims 2-7, 9-13, and 15-20 ultimately depends from  
20 either claim 1, 8, or 14, the Applicants submit that each of claims 2-7, 9-13, and 15-20 is patentable for at least the same reasons discussed above with respect its independent claim.

In view of the foregoing, the Applicants kindly request that the Office withdraw the rejections of claims 1-20. The Applicants respectfully submit that all of the pending  
25 claims are in condition for allowance. Therefore, a notice of allowance is requested. If the

Examiner has any questions concerning the present Amendment, the Examiner is kindly requested to contact the undersigned at (408) 774-6914. If any additional fees are due in connection with filing this Amendment, the Commissioner is also authorized to charge Deposit Account No. 50-0805 (Order No. SUNMP016). A duplicate copy of the transmittal is enclosed for this purpose.

Respectfully submitted,  
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